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No. 02-429

In the Supreme Court of the United States

DETHMERS MANUFACTURING COMPANY, INC.,
PETITIONER

v.

AUTOMATIC EQUIPMENT MANUFACTURING COMPANY

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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23 pp

QUESTIONS PRESENTED

1. Whether a court may declare a patent claim approved by the United States Patent and Trademark Office (PTO) invalid based solely on a judicial finding that the applicant failed, during the patent-application process, to comply with a procedural regulation of the PTO.

2. If so, whether the PTO's determination that the applicant complied with PTO procedural regulations is entitled to judicial deference.

TABLE OF CONTENTS

	Page
Statement	1
Discussion	8
I. The court of appeals' decision invalidates patent claims based on a non-statutory ground, in violation of 35 U.S.C. 282	8
II. The court of appeals erred when it undertook non-deferential, *de novo* review of petitioner's compliance with Rule 175	13
Conclusion	18

TABLE OF AUTHORITIES

Cases:

Auer v. *Robbins*, 519 U.S. 452 (1997)	14
Bayer AG v. *Carlsbad Tech., Inc.*, 298 F.3d 1377 (Fed. Cir. 2002)	16
Bowles v. *Seminole Rock & Sand Co.*, 325 U.S. 410 (1945)	14
Chamberlain Group, Inc. v. *Interlogix, Inc.*:	
No. 01 C 6157, 2002 WL 1263984 (N.D. Ill. June 3, 2002)	12
No. 01 C 6157, 2002 WL 1998292 (N.D. Ill. Aug. 28, 2002)	12
Constant, In re, 827 F.2d 728 (Fed. Cir.), cert. denied, 484 U.S. 894 (1997)	5
Diamond v. *Chakrabarty*, 447 U.S. 303 (1980)	10
Dickinson v. *Zurko*, 527 U.S. 150 (1999)	6, 7, 15
Exxon Corp. v. *Phillips Petroleum*, 265 F.3d 1249 (Fed. Cir. 2001)	12
Festo Corp. v. *Shoketsa Kinzoku Kogyo Kabushiki*, 234 F.3d 558 (Fed. Cir. 2000), vacated, 535 U.S. 722 (2002)	13
Hyatt v. *Boone*, 146 F.3d 1348 (Fed. Cir. 1998), cert. denied, 525 U.S. 1141 (1999)	11, 16

Cases—Continued: Page

J.E.M. AG Supply, Inc. v. *Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124 (2001) 10
Kingsdown Med. Consultants, Ltd. v. *Hollister Inc.*, 863 F.2d 867 (Fed. Cir. 1988), cert. denied, 490 U.S. 1067 (1989) 11-12
Kubota v. *Shibuya*, 999 F.2d 517 (Fed. Cir. 1993) 16
Magnivision, Inc. v. *Bonneau Co.*, 115 F.3d 956 (Fed. Cir. 1987), cert. denied, 522 U.S. 1090 (1998) 11
Martin v. *Occupational Safety & Health Review Comm'n*, 499 U.S. 144 (1991) 15
McDaniel, In re, 293 F.3d 1379 (Fed. Cir. 2002) 16
Nupla Corp. v. *IXL Mfg. Co.*, 114 F.3d 191 (Fed. Cir. 1997) 5, 12
Seiko Epson Corp. v. *Nu-Kote Int'l, Inc.*, 190 F.3d 1360 (Fed. Cir. 1999) 12
Stairmaster Sports/Med. Prods., Inc. v. *Groupe Procycle, Inc.*, 25 F. Supp. 2d 270 (D. Del. 1998) 12
Thomas Jefferson Univ. v. *Shalala*, 512 U.S. 504 (1994) 15
Toro Co. v. *Ariens Co.*, No. CIV.3-96-416, 1998 WL 34024138 (D. Minn. Sept. 2, 1998) 12
United States v. *Armstrong*, 517 U.S. 456 (1996) 14
United States v. *Chemical Found., Inc.*, 272 U.S. 1 (1926) 14
United States Postal Serv. v. *Gregory*, 534 U.S. 1 (2001) 14
Vermont Yankee Nuclear Power Corp. v. *Natural Res. Def. Council, Inc.*, 435 U.S. 519 (1978) 15
Westvaco Corp. v. *International Paper Co.*, 991 F.2d 735 (Fed. Cir. 1993) 2

Statutes, regulations and rule:

Administrative Procedure Act, 5 U.S.C. 706 ..... 6-7, 12

Statutes, regulations and rule—Continued: Page

Patent Act, ch. 950, 66 Stat. 792 (35 U.S.C. 1 *et seq.*):
- 35 U.S.C. 2(b) 2
- 35 U.S.C. 2(b)(2)(A) 7
- 35 U.S.C. 6(a) (1994) 3, 10
- 35 U.S.C. 111(a)(2)(C) 2
- 35 U.S.C. 115 2-3
- 35 U.S.C. 251 ..... 2, 4, 5, 9, 10
- 35 U.S.C. 252 ..... 2, 8-9
- 35 U.S.C. 282 ..... 2, 8, 12, 14, 16
- 35 U.S.C. 282(2) 9
- 35 U.S.C. 282(3) 9

28 U.S.C. 1295(a)(1) 6, 8, 17
28 U.S.C. 1295(a)(4) 8, 17
37 C.F.R.:
- Section 1.60 (1996) 5, 11
- Section 1.171 14
- Section 1.171 (1996) 3
- Sections 1.171-1.179 ..... 3, 9
- Section 1.175 (1996) (Rule 175) ..... *passim*
- Section 1.175 3
- Section 1.175(a) (1996) 3
- Section 1.175(a)(1) 3
- Section 1.178 2
- Section 1.183 ..... 3, 10
- Section 1.191 17

Fed. R. Civ. P. 54(b) 6

Miscellaneous:

62 Fed. Reg. (1997):
- p. 53,132 3
- pp. 53,165-53,166 3
- p. 53,196 3

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This brief is submitted in response to the Court's order inviting the Solicitor General to express the views of the United States.

STATEMENT

Petitioner seeks review of a decision of the United States Court of Appeals for the Federal Circuit that implicates important and recurring issues about the validity of patents issued by the United States Patent and Trademark Office (PTO), and whether courts should defer to the PTO's applications of its own procedural regulations. The decision of the court of appeals is incorrect, but it appears to involve only a limited departure from that court's generally correct

approach to similar issues. Moreover, the PTO has revised the particular administrative regulation that is at issue in this case. Because it is not yet clear whether the errors of the court of appeals will have significance beyond the narrow factual context presented in this case, review by this Court is unwarranted.

1. The Patent Act, 35 U.S.C. 251, authorizes the Director of the PTO to grant applications for the reissuance of patents, in order to correct errors that otherwise would render original patents wholly or partly inoperative or invalid. Patents are reissued "by reason of a defective specification or drawing" in the original patent application, "or by reason of the patentee claiming more or less than he had a right to claim in the patent." Reissuance is not available, however, if the errors sought to be corrected were made with a "deceptive intention." A reissue patent provides the patent holder protection for the remaining part of the term of the original patent. 35 U.S.C. 251.

To obtain reissuance of a patent, the patent holder must file a reissue application within two years of the grant of the original patent, and surrender (or offer to surrender) the original patent. 35 U.S.C. 251; see 37 C.F.R. 1.178. Reissue patents "have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form." 35 U.S.C. 252. Therefore, a reissue patent is vested with the statutory presumption of validity that applies to all issued patents. See 35 U.S.C. 282; *Westvaco Corp.* v. *International Paper Co.*, 991 F.2d 735, 745 (Fed. Cir. 1993).

The patent laws do not require an applicant for a reissue patent to file a supporting declaration other than the standard declaration that must be filed with any patent application under 35 U.S.C. 111(a)(2)(C) and

115. However, pursuant to its authority under 35 U.S.C. 2(b) to establish procedural regulations, the PTO has established rules governing reissue applications.[1] See 37 C.F.R. 1.171-1.179. During the relevant time period in this case, PTO Rule 175 (37 C.F.R. 1.175 (1996)) required a reissue applicant to file, with the reissue application, a declaration "particularly" or "distinctly" specifying each of the alleged defects or errors in the original patent and stating that they occurred without deceptive intent. 37 C.F.R. 1.175(a) (1996); see 37 C.F.R. 1.171 (1996) (reissue application must comply with requirements of rule). The PTO's regulations further provided (and continue to provide) that any requirement of the rules that is not required by statute may be waived or suspended in an extraordinary situation, when justice requires. 37 C.F.R. 1.183.

In 1997, the PTO revised Rule 175. See *Changes to Patent Practice and Procedure*, 62 Fed. Reg. 53,132, 53,165-53,166, 53,196 (1997). Most importantly, whereas the rule formerly required the reissue applicant to specify with particularity every alleged error in the original patent, the current rule requires that the applicant must state in the reissue declaration "at least one error being relied upon as the basis for reissue." 37 C.F.R. 1.175(a)(1).

2. In August 1993, the PTO issued a patent, later acquired by petitioner, for collapsible and removable hitches for towing vehicles. Pet. App. 3, 39. The patented tow-hitch would be used, for example, to tow a car behind a motor home. *Id.* at 3. In March 1995, petitioner applied for reissuance of the original tow-hitch

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[1] Similar rulemaking authority previously was vested in the Commissioner of Patents and Trademarks, acting with the approval of the Secretary of Commerce. See 35 U.S.C. 6(a) (1994).

patent. Petitioner asserted in its reissue application that the original patent application was unnecessarily narrow, and that the error was made without deceptive intent. *Id.* at 3, 57. In December 1995, a patent examiner rejected the reissue application because petitioner's supporting declaration did not provide the detailed information then required by Rule 175 (which had not yet been revised by the PTO). Pet. App. 3-4, 136. Petitioner filed a substitute declaration, which the examiner accepted as the basis for granting the reissue patent in March 1997. *Id.* at 4, 137-140.

3. In June 1996, while its reissue application was pending, petitioner sued respondent in the United States District Court for the Northern District of Iowa, seeking a declaratory ruling that it was not infringing a tow-hitch patent owned by respondent, and declaratory, injunctive, and damages relief for respondent's alleged infringement of a patent owned by petitioner. Pet. App. 38. In November 1997, after the PTO issued the reissue patent to petitioner, petitioner filed an amended complaint that sought a declaratory judgment of non-infringement of respondent's tow-hitch patent, and declaratory, injunctive, and damages relief for respondent's alleged infringement of petitioner's newly reissued patent. *Id.* at 38-39. Petitioner also brought contract, tort, and other claims against respondent, see *id.* at 39, which are not relevant to the instant petition for a writ of certiorari.

In defending against the patent-infringement claim, respondent filed a motion for summary judgment in which it asserted that petitioner's reissue patent was invalid for failure to comply with the requirements of the reissue statute, 35 U.S.C. 251. See Pet. App. 4, 41. Respondent also claimed that petitioner's substituted reissue declaration was fatally defective under former

PTO Rule 175 because the declaration did not detail particularly and specifically each alteration to, or departure from, the claims in the original patent. See *id.* at 4-5, 41.

The district court denied respondent's motion for summary judgment insofar as respondent contested the validity of the reissue patent under 35 U.S.C. 251. Pet. App. 114-130, 188. Nevertheless, the court granted summary judgment for respondent on its claim that the reissue patent was invalid for noncompliance with former Rule 175. Pet. App. 130-144, 188. The district court relied on *Nupla Corp.* v. *IXL Manufacturing Co.*, 114 F.3d 191 (1997), in which the Federal Circuit held that a reissue patent was invalid because the applicant failed to submit a declaration that complied with Rule 175, as the rule had been construed in *In re Constant*, 827 F.2d 728 (Fed. Cir.), cert. denied, 484 U.S. 894 (1997). See *Nupla*, 114 F.3d at 192-196. The district court explained that the Federal Circuit's decisions in *Nupla* and *Constant* "require[] strict compliance with the regulations, which in turn strictly require that '[e]very departure from the original patent . . . must be particularly and distinctly specified and supported in the original, or a supplemental, reissue oath or declaration.'" Pet. App. 133 (quoting 37 C.F.R. 1.175 (1996)). The district court acknowledged "the drastic effect" of declaring petitioner's reissue patent invalid, and noted "the heavy burden required for proof of invalidity." *Id.* at 142; see *Nupla*, 114 F.3d at 192-193 ("Patents have a statutory presumption of validity [under 35 U.S.C. 282], which can only be overcome by clear and convincing evidence [of invalidity]."). However, the district court deemed its determination of patent invalidity to be "dictated by the *Nupla* and *Constant* line of cases." Pet. App. 143.

In November 1999, pursuant to Federal Rule of Civil Procedure 54(b), the district court entered final judgment on the patent and patent-related claims (including respondents' claim of invalidity based on a failure to comply with former Rule 175). Pet. App. 190-191; see 189 F.R.D. 526 (N.D. Iowa 1999).

4. A divided panel of the United States Court of Appeals for the Federal Circuit—which has exclusive appellate jurisdiction under 28 U.S.C. 1295(a)(1)—affirmed, in part, the grant of summary judgment for respondent on the patent-invalidity issue. Pet. App. 1-33. The panel majority concluded that *Nupla* and *Constant* require a *de novo* determination whether petitioner's substituted reissue declaration satisfied Rule 175, "without deference to previous administrative determinations." *Id.* at 8 & n.2. Disagreeing with the patent examiner's determination that the substituted reissue declaration satisfied Rule 175, but also with the district court's determination that the reissue patent is entirely invalid, the court of appeals concluded that noncompliance with Rule 175 rendered four of petitioner's ten distinct reissue claims invalid. *Id.* at 6-22.[2]

Judge Dyk dissented in part, Pet. App. 24-33, stating that the panel should have "defer[red] to the PTO's interpretation of its own regulations," *id.* at 24. In his view (*id.* at 26), the patent examiner's application of PTO Rule 175 in the circumstances of this case was entitled to judicial deference under the reasoning of *Dickinson* v. *Zurko*, 527 U.S. 150 (1999), in which this Court held that the "ordinary * * * court/agency standards" of the Administrative Procedure Act,

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[2] The court of appeals also affirmed the district court's holding that prosecution-history estoppel barred one of respondent's patent-infringement claims. Pet. App. 22-23.

5 U.S.C. 706, apply when the Federal Circuit reviews findings of fact made by the PTO. 527 U.S. at 153, 154. Judge Dyk observed that "[g]iving deference to agency interpretations of their own regulations has long been the rule," Pet. App. 27, and that the Federal Circuit has in other cases deferred to the PTO's interpretations of its own regulations, *id.* at 28-29. Judge Dyk saw "no basis for treating the PTO differently from any other administrative agency," *id.* at 30, and emphasized that Congress expressly conferred on the PTO the power to establish procedural regulations, *ibid.* (citing 35 U.S.C. 2(b)(2)(A)).

Turning to the facts of this case, Judge Dyk identified a "fundamental difference" between the majority's requirement of "almost perfect compliance" with the specificity requirements of former Rule 175, and the PTO's acceptance of petitioner's "reasonable compliance." Pet. App. 31. Judge Dyk concluded, for each of the reissue claims as to which the majority found petitioner's substituted declaration inadequate, that the patent examiner reasonably found the declaration to be in compliance with Rule 175. *Id.* at 31-33.

5. The court of appeals denied petitioner's request for rehearing en banc by an evenly divided vote. Pet. App. 193, 199. The six dissenting judges concluded (*id.* at 194-196 (Linn, J., dissenting)) that the panel's decision is inconsistent with the judicial presumption of administrative regularity, as well as the statutory presumption of patent validity, insofar as it holds "that a patent may be invalidated due to an examiner's misapplication of a PTO procedural rule," *id.* at 196. The dissent further noted that non-compliance with PTO rules is "a ground of invalidity not included in the exclusive list of grounds for invalidating a patent set forth in 35 U.S.C. § 282." *Ibid.* Consistent with Judge Dyk's

dissent from the panel's decision, the dissenting judges also stated that "application of the de novo standard of review in the context of this case, following *Nupla*, is contrary to the deference owed to PTO interpretations of its own procedural rules." *Ibid.*; see *id.* at 197-198 (Dyk, J., dissenting) (stating that panel's decision "perpetuates a serious anomaly in the patent law" and that "[r]esolution of the deference issue * * * is of exceptional importance") (internal quotation marks omitted).[3]

DISCUSSION

As six judges of the Federal Circuit have noted, this case presents significant and potentially far-reaching issues of patent law. The Federal Circuit, which has exclusive jurisdiction over patent appeals, see 28 U.S.C. 1295(a)(1) and (4), resolved those issues incorrectly, in violation of the governing statutory requirements and decisions of this Court. Nevertheless, the Federal Circuit's generally correct resolution of similar issues in other recent patent cases, together with the 1997 revision to Rule 175 and certain features of this case, counsel against granting the petition.

I. THE COURT OF APPEALS' DECISION INVALIDATES PATENT CLAIMS BASED ON A NON-STATUTORY GROUND, IN VIOLATION OF 35 U.S.C. 282

A. Section 282 of Title 35, United States Code, states that a patent (including a reissue patent, see 35

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[3] The PTO, which had filed a brief as amicus curiae in support of petitioner at the panel's invitation, see Pet. App. 24 (Dyk, J., dissenting), also filed an amicus brief in support of the petition for en banc review. The PTO urged rehearing en banc on the grounds that the panel's decision is incorrect and conflicts on important questions with other Federal Circuit decisions. See *id.* at 205-211.

U.S.C. 252), and each separate claim of a patent, "shall be presumed valid. * * * The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." 35 U.S.C. 282.

Section 282 also lists the specific grounds on which a defense of patent invalidity may be based when defending against a claim of patent infringement. Those grounds are "[i]nvalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability," 35 U.S.C. 282(2), and "[i]nvalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title," 35 U.S.C. 282(3). Section 282 thus authorizes a determination of patent invalidity for failure to comply *with the statutory reissue requirements of 35 U.S.C. 251*, but does not authorize a determination of patent invalidity when it is alleged that the patent holder, in applying for the reissue patent, failed to follow nonstatutory procedural requirements adopted by the PTO in its regulations.

In this case, the district court rejected respondent's contentions that petitioner failed to comply with the statutory criteria for obtaining a reissue patent. See Pet. App. 114-130. That statutory issue was not before the court of appeals. See *id.* at 4-6. Insofar as is relevant to the pending petition for a writ of certiorari, the court of appeals addressed *only* "whether [petitioner's] substitute reissue declaration satisfies the requirements of Rule 175," 37 C.F.R. 1.175 (1996). Pet. App. 6.

The specificity requirements of 37 C.F.R. 1.175 (1996) exceeded the requirements of the reissue statute, 35 U.S.C. 251. Although Rule 175 was "issued under" Section 251, see 37 C.F.R. 1.171-1.179 note (1996), Section 251 does not provide for the detailed reissue declaration that 37 C.F.R. 1.175 (1996) demanded. There is no

suggestion in this case that the specificity requirements of former Rule 175—which the PTO could suspend or waive, see 37 C.F.R. 1.183—were necessary for compliance with Section 251. Instead, the requirements of former Rule 175 were established to assist the PTO in its own assessment of reissue applications, and were promulgated in the exercise of the agency's discretionary administrative power to "establish regulations, not inconsistent with law, for the conduct of proceedings in the [PTO]." 35 U.S.C. 6(a) (1994); see 35 U.S.C. 2(b)(2). Those procedural requirements in former Rule 175 were not fashioned to confer on third parties such as respondent, who do not participate in the reissue proceedings before the PTO, any rights of a sort that could be invoked in private litigation.

In relying upon the procedural requirements of Rule 175 to invalidate petitioner's patent claims, the court of appeals disregarded that "Congress, not the courts, must define the limits of patentability." *J.E.M. AG Supply, Inc.* v. *Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 130 (2001) (quoting *Diamond* v. *Chakrabarty*, 447 U.S. 303, 315 (1980)). The statutory limitations on declaring a patent invalid embody Congress's judgment about the circumstances under which a patent holder should forfeit protection that results from PTO approval. By invalidating an issued patent based on a ground not specified in the Patent Act and not deemed preclusive of patent protection by the PTO, the court of appeals' decision narrows the patent protection afforded by Congress.

B. Unlike the court of appeals' decision here, other decisions of the Federal Circuit correctly state that procedural infirmities in a patent application generally do not provide grounds to hold the patent invalid. For example, when it reviewed a decision of the Board of

Patent Appeals and Interferences in *Hyatt* v. *Boone*, 146 F.3d 1348 (Fed. Cir. 1998), cert. denied, 525 U.S. 1141 (1999), the court of appeals rejected an objection to the rights of a patent holder that was based on alleged "technical violation[s]" (*id.* at 1355) of former 37 C.F.R. 1.60, which established streamlined filing requirements for patent applications covering subject matter already disclosed in an earlier application. The court explained that "[a]ny technical deficiency in meeting the formal requirements of [the PTO rule] must be viewed in light of the agency's acceptance of the applications as in compliance with the Rule. Regularity of routine administrative procedures is presumed, and departure therefrom, should such have occurred, is not grounds of collateral attack." 146 F.3d at 1355. The court of appeals added that "[c]ourts should not readily intervene in the day-to-day operations of an administrative agency." *Ibid.*

Magnivision, Inc. v. *Bonneau Co.*, 115 F.3d 956 (Fed. Cir. 1997), cert. denied, 522 U.S. 1090 (1998), involved claimed irregularities in documenting contacts between a patent examiner and the attorney for a patent applicant. The Federal Circuit stated that whereas "[a] court may invalidate a patent on any substantive ground, whether or not that ground was considered by the patent examiner[,] * * * [p]rocedural lapses during examination, should they occur, do not provide grounds of invalidity." *Id.* at 960. "Absent proof of inequitable conduct," the court of appeals continued, "the examiner's or the applicant's absolute compliance with the internal rules of patent examination becomes irrelevant after the patent has issued." *Ibid.*; see *Kingsdown Med. Consultants, Ltd.* v. *Hollister Inc.*, 863 F.2d 867, 872 (Fed. Cir. 1988) ("Inequitable conduct resides in failure to disclose material information, or

submission of false material information, with an intent to deceive."), cert. denied, 490 U.S. 1067 (1989). Other recent Federal Circuit decisions are to the same effect. See *Exxon Corp.* v. *Phillips Petroleum*, 265 F.3d 1249, 1252-1254 (Fed. Cir. 2001); *Seiko Epson Corp.* v. *Nu-Kote Int'l, Inc.*, 190 F.3d 1360, 1367 (Fed. Cir. 1999) ("Technical violations of PTO procedures, absent fraud or intentional deception, are not inequitable conduct as would invalidate the patent.").[4]

The rule established in *Nupla Corp.* v. *IXL Manufacturing Co.*, 114 F.3d 191 (Fed. Cir. 1997), and followed in this case therefore is in considerable tension with the main current of Federal Circuit precedent, which correctly holds that patents issued by the PTO may not be invalidated for a good-faith failure to comply with PTO procedural requirements. Moreover, there appear to be only a few decisions in which district courts have followed *Nupla* and entertained a claim of patent invalidity based on noncompliance with Rule 175. See *Stairmaster Sports/Med. Prods., Inc.* v. *Groupe Procycle, Inc.*, 25 F. Supp. 2d 270, 290-291 (D. Del. 1998) (applying former version of Rule 175); *Toro Co.* v. *Ariens Co.*, No. CIV.3-96-416, 1998 WL 34024138, at *15-*16 (D. Minn. Sept. 2, 1998) (same); see also *Chamberlain Group, Inc.* v. *Interlogix, Inc.*, No. 01 C 6157, 2002 WL 1263984 (N.D. Ill. June 3, 2002) (applying current version of Rule 175), and *Chamberlain Group, Inc.* v. *Interlogix, Inc.*, No. 01 C 6157, 2002 WL 1998292, at *2 (N.D. Ill. Aug. 28, 2002) (noting that patent holder did not raise argument that 35 U.S.C. 282

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[4] These other decisions of the Federal Circuit are consistent with the general rule under the Administrative Procedure Act that, on judicial review, "due account shall be taken of the rule of prejudicial error." 5 U.S.C. 706.

does not authorize court to invalidate patent based on Rule 175).

An additional consideration is the 1997 revision to Rule 175, which relaxed the rule's requirements for describing errors in the original patent. Because of the relaxed description requirement, it is considerably less likely that courts will find patents examined under the new rule invalid under the *Nupla* approach (as reaffirmed in this case) for failure to comply with Rule 175.[5] For those reasons, it does not appear at the present time that the first question presented in the petition has sufficient prospective importance to warrant this Court's review.

II. THE COURT OF APPEALS ERRED WHEN IT UNDERTOOK NON-DEFERENTIAL, *DE NOVO* REVIEW OF PETITIONER'S COMPLIANCE WITH RULE 175

For the reasons stated in Point I.A., above, the court of appeals erred in holding that its finding of non-compliance with Rule 175 could alone support a judicial declaration of patent invalidity. If the Court granted review and reversed on that ground, it would be unnecessary to address the second question presented in the petition—whether the PTO examiner's determination of petitioner's compliance with Rule 175 was entitled to judicial deference. The court of appeals erred

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[5] The PTO has determined that there are approximately 2000 reissue patents that were examined under the old version of Rule 175, and that have not expired or lapsed for non-payment of maintenance fees. By way of comparison to the broader universe, there are approximately 1.2 million unexpired, enforceable patents. See *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 618 (Fed. Cir. 2000) (en banc) (Michel, J., concurring in part and dissenting in part), vacated, 535 U.S. 722 (2002).

on the latter question as well, but it is not independently worthy of review in the context of this particular case.

A. The patent examiner must be understood to have determined, in granting the reissue patent, that petitioner's substituted declaration corrected the initial noncompliance with former Rule 175. See p. 4, *supra*; 37 C.F.R. 1.171 (requiring compliance with Rule 175). At the very least, the examiner reasonably determined that the substitute declaration *sufficiently* complied with Rule 175 to fulfill its purpose of allowing the examiner to pass upon the reissue application. The examiner's determination enjoys a double presumption of correctness. First, the reissue patent is entitled to the statutory presumption of validity. See 35 U.S.C. 282. Second, the PTO's approval of the reissue application is itself entitled to the "presumption of regularity [that] attaches to the actions of Government agencies." *United States Postal Serv.* v. *Gregory*, 534 U.S. 1, 10 (2001). "[I]n the absence of clear evidence to the contrary, courts presume that [public officials] have properly discharged their official duties," *United States* v. *Armstrong*, 517 U.S. 456, 464 (1996) (quoting *United States* v. *Chemical Found., Inc.*, 272 U.S. 1, 14-15 (1926)), such as verifying petitioner's compliance with Rule 175.

Well-settled principles of judicial deference reinforce the presumption that the PTO issued petitioner's reissue patent in accordance with the applicable procedural requirements. This Court has held consistently that administrative agencies' interpretations of their own regulations are entitled to substantial deference. See, *e.g.*, *Auer* v. *Robbins*, 519 U.S. 452, 461-463 (1997); *Bowles* v. *Seminole Rock & Sand Co.*, 325 U.S. 410, 414 (1945). As the Court explained in *Thomas Jefferson*

University v. *Shalala*, 512 U.S. 504 (1994), which involved a denial of Medicare reimbursement under a regulation promulgated by the denying agency, an agency's interpretation of its own regulation "must be given controlling weight unless it is plainly erroneous or inconsistent with the regulation." *Id.* at 512 (internal quotation marks omitted).

Judicial deference extends to interpretations made in agency adjudications and enforcement actions, as well as rule-makings and policy statements. See *Martin* v. *Occupational Safety & Health Review Comm'n*, 499 U.S. 144, 154 (1991) ("[A]djudication operates as an appropriate mechanism * * * for the exercise of delegated lawmaking powers, including lawmaking by interpretation."); see also *id.* at 157 (agency enforcement citation provided valid means of interpreting regulations). Furthermore, deference is particularly warranted where, as here, the pertinent regulation establishes the agency's own internal procedures. "[T]he formulation of [those] procedures [is] basically to be left within the discretion of the agencies to which Congress had confided the responsibility for substantive judgments." *Vermont Yankee Nuclear Power Corp.* v. *Natural Res. Def. Council, Inc.*, 435 U.S. 519, 524 (1978). That is especially so where, as here, the regulation is designed to assist the agency in conducting its own review, in proceedings to which the person now seeking to invoke the regulation was not a party.

For those reasons, the court of appeals erred when it treated the PTO's determination of petitioner's compliance with Rule 175 as "a pure question of law" subject to *de novo* review. See Pet. App. 6, 8 & n.2. As in *Dickinson* v. *Zurko*, 527 U.S. 150 (1999), the court of appeals should at a minimum have applied ordinary

principles of judicial deference to the agency's decision-making.

B. As with the first question presented in the petition, however, the court of appeals' error on the deference issue does not warrant this Court's review at the present time. Because the judgment below is incorrect for the antecedent reason that a violation of Rule 175 is not a ground for declaring a patent invalid under 35 U.S.C. 282, the deference issue might not be resolved by this Court even if the petition were granted.

Furthermore, the Federal Circuit has in other contexts recognized that the PTO's interpretations of its own regulations are entitled to judicial deference. See, *e.g.*, *Bayer AG* v. *Carlsbad Tech., Inc.*, 298 F.3d 1377 (Fed. Cir. 2002); *Kubota* v. *Shibuya*, 999 F.2d 517, 520-521 (Fed. Cir. 1993); see also *Hyatt* v. *Boone*, 146 F.3d 1348, 1355-1356 (Fed. Cir. 1998), cert. denied, 525 U.S. 1141 (1999); *In re McDaniel*, 293 F.3d 1379, 1382, 1385 (Fed. Cir. 2002) (noting deference requirement, but stating that the instant case established an exception to general rule). The full scope of the inconsistent approach suggested by *Nupla* and this case is unclear at the present time. In particular, the Federal Circuit has not applied *Nupla* to reissue patents examined under the current version of Rule 175, and it is possible that, in future cases, the Federal Circuit might approach that issue with greater sensitivity to principles of judicial deference.

Finally, because of the context in which this case arose, the administrative record is not as fully developed as it often would be in a case involving the principle that courts must defer to the PTO's interpretations of its own regulations. The patent examiner's grant of the reissue patent, in the non-adversarial reissue proceeding, subsumed an implicit finding that

petitioner's substituted declaration was sufficient to cure the deficiency of the earlier supporting declaration, and therefore to comply with former Rule 175. And because the reissue patent application was granted, there was no proceeding before the PTO's Board of Patent Appeals and Interferences that might have generated a decision that addressed the issue in detail. See generally 37 C.F.R. 1.191. Furthermore, although the PTO's amicus curiae brief during the panel's proceedings in the court of appeals argued that judicial deference is appropriate, see Pet. App. 24 & n.1 (Dyk, J., dissenting), it did not address the correct application of Rule 175 to the facts of this case. The rule that the PTO's interpretations and applications of its regulations deserve judicial deference might be more helpfully illustrated in a case in which the agency record is more fully developed.

Despite the limitations of this case as a vehicle for further review, the issue of judicial deference to PTO decisions is important and recurring. Moreover, in light of the Federal Circuit's exclusive jurisdiction over actions arising under the Patent Act, see 28 U.S.C. 1295(a)(1) and (4), review by this Court may become necessary to resolve inconsistencies in the Federal Circuit's adherence to the deference requirement. The United States suggests, however, that a correct resolution of the deference issue through the Federal Circuit's own mechanisms remains possible, and consideration of the issue by this Court is unwarranted at the present time, under the circumstances presented by this case.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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